1638

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2/6/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of
DUWEING et al.

Serial No. 09/636,826

Filed: August 14, 2000

) Group Art Unit: 1638
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) Examiner: Collins
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For: PLANT GENE EXPRESSION UNDER THE CONTROL OF CONSTITUTIVE PLANT V-ATPASE PROMOTERS

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:

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Herbert B. Keil
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Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20031

Sir:

REPLY TO RESTRICTION REQUIREMENT

This communication is in response to the office communication dated November 30, 2001.

REMARKS

Provisional election with traverse:

The examiner separated the present invention into 6 groups (I-VI) and required the applicants to elect one. In compliance with 37 CFR 1.143, applicants elect with traverse **Group I** (claims 1, 3-7, 9-11, 13-16, 17-41 and 43-54, drawn to a DNA construct with a plant V-ATPase promoter of *Beta vulgaris* V-ATPase subunit c isoform

2 [SEQ ID NO:1], a polynucleotide of SEQ ID NO: 1, a recombinant vector, a microorganism, a transgenic plant and plant cell, methods of expressing a heterologous gene, and uses of the DNA construct and promoter, classified in class 435, subclass 419, for example).

Argument:

Applicants herein distinctly and specifically point out errors in the restriction requirement as required by MPEP § 818.03(c).

35 USC 121 states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application. The term "independent" means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process. MPEP § 802.01. The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art). MPEP § 802.01.

Applicants disagree with the examiner's conclusion that the inventions of Groups

I-VI are distinct products. The examiner essentially states the same reason for concluding that Groups I-VI each are separate inventions. This reasons is that the products, whether they are recombinant proteins or DNA constructs, can be used differently. However, this is not sufficient to comply with above cited requirement that restriction be imposed only when there are independent and distinct inventions. Therefore, applicants request that the restriction requirement of November 30, 2001 be withdrawn.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such account.

Respectfully submitted,
KEIL & WEINKAUF

Herbert B. Keil
Reg. No. 18,967

1101 Connecticut Ave., N.W.
Washington, D.C. 20036
(202)659-0100
HBK/DSK/lc